

## REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Office Action dated February 3, 2010. With this Response, Applicants have amended claims 1, 8-12 and 17. Claims 2-7, 13-16, 18-33, 37, and 39 are canceled. Claims 34-36, 38, 40 and 41 stand withdrawn. New claims 42-49 are added. Claims 1, 8-12, 17, 34-36, 38, and 40-49 are pending in this application.

### I. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e) - SUGIURA

In the Office Action, claims 1, 8-12 and 17 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Sugiura* (U.S. Pat. Pub. No. 2004/0115550, hereinafter "*Sugiura*"). The Office Action takes the position that

*Sugiura* discloses a developer comprising a toner particles and a carrier liquid (PP 0198). The toner may comprise thermoplastic resin particulates (PP 0139). The toner may comprise a polyethylene wax (paragraph [0130]) in an amount of 1-40% by weight (PP 0131). The toner may comprise different resins (PP 0038), and the two resins may have different properties (PP 0047).

Applicants respectfully submit that *Sugiura* does not disclose polyethylene wax additive particles dispersed in the resin of the toner particles (as per claim 1), much less polyethylene wax particles 1-20 micrometers in diameter dispersed in the resin of the toner particles. To the contrary, at paragraph [0130], *Sugiura* discloses in paragraphs [0293]-[0294] that an aqueous dispersion of a vinyl resin is mixed with an oil phase containing a wax/colorant/binder dispersion (paragraphs [0300]-[0302]), and those two phases are then mixed to form a toner cake (paragraphs [0303]-[0308]). Thus, the toner composition of *Sugiura* appears to be a mixture of resin particles and wax/colorant/binder particles. By comparison, claim 1 defines a liquid toner in which the toner particles comprise a resin in which certain 1-20 micron additive particles are dispersed. Based on at least the aforesaid differences, claim 1, and claims 8-12 and 17 which depend therefrom, are not anticipated by *Sugiura*.

## II. CLAIM REJECTION UNDER 35 U.S.C. § 103(a) - SUGIURA

In the Office Action, claim 12 is rejected in the alternative under 35 U.S.C. § 103(a) as allegedly being obvious over *Sugiura*. The Office Action takes the position that *Sugiura* teaches that a thermoplastic resin is used, but fails to teach the melt flow index of the resin. The Office Action further states that when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67,205 USPQ 594 (CCPA 1980)," citing MPEP §§ 2112- 2112.02.

Applicants respectfully submit that even if, *arguendo*, a resin disclosed by *Sugiura* were thermoplastic and possessed a melt flow index less than or equal to 100 (as per claim 12), this would not make up for the above-described failure of *Sugiura* to teach all of the limitations of claim 1, from which claim 12 depends. For at least this reason, claim 12 is nonobvious over *Sugiura*.

## III. CLAIM AMENDMENTS

Claim 1 is currently amended to correct an obvious typographical or transcriptional error in which "up" was unintentionally omitted from in the phrase "the additive particles make up at least 10%... ." Claim 1 is also amended to recite "% by weight" for better conformity with the wording of claims 8-10. These amendments are supported at page 3, lines 26-27 and original claims 8-10, for example, of the specification.

Claims 8-12 and 17 are currently amended to recite "The matte toner" instead of "A matte toner," for better claim form. Claim 12 is further amended to recite "resin" instead of "resins" for grammatical reasons. Claim 17 is further amended for better conformity with the wording of claim 1.

New claims 42-49 are added to reintroduce the subject matter of original claims 3-7 and 13-16, respectively. The new claims depend from claim 1 and are properly included in the elected Group I claims. New claims 42-49 are patentable

over *Sugiura* for at least the same reasons as stated above with respect to claim 1. No new matter is introduced by way of any of the amendments.

#### **IV. REQUEST FOR REJOINDER OF GROUP III**

The withdrawn claims of Group III (claims 34-36, 38 and 40-41) depend directly or indirectly from claim 1 and incorporate all of the limitations thereof. As claim 1 is patentable over the cited reference for at least the reasons stated above, unity of invention exists between elected Group I and withdrawn Group III. Consistent with the Decision on Petition mailed September 21, 2009, Applicants request withdrawal of the restriction requirement as to Group III. Claims 34-36, 38 and 40-41 are patentable over *Sugiura* for at least the same reasons as stated above regarding claim 1.

#### **V. CONCLUSION**

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and withdrawal of the rejections and allowance of all pending Group I and Group III claims in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of

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claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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